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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/499,238
Filing Date: February 07, 2000
Appellant(s): STOBBS ET AL.

_____
Gregory A. Stobbs
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 02/16/2009 appealing from the Office action

mailed 09/15/2008.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application: 1-7, 11-22, 31, and 32.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

6,038,561	SNYDER	3-2000
6,018,714	RISEN	1-2000
6,049,811	PETRUZZI	4-1999
6,339,767	RIVETTE	1-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

        This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

2.   Claims 1-7, 11-16, 18-22, and 31-32 are rejected under 35 U.S.C. 103(a) as

being unpatentable over **Snyder et al. ("Snyder")** (U.S. Patent 6,038,561) in view of

Risen, Jr. et al. ("Risen") (U.S. Patent 6,018,714) and **Petruzzi et al. ("Petruzzi")** (U.S.

Patent 6049811 A).

        Regarding claim 1, **Snyder** teaches a computer implemented patent portfolio

analysis method comprising:

        a).   retrieving a corpus of patent information from a database, said information

including multiple claims from a plurality of patent documents (col. 4, lines 3-7 and lines

8-18);

Snyder further teaches analysis of structured documents such as claims within patents, accurately compare claims from two different patents in attempt to identify both the scope and references of the claims. Additionally, the system translate a set of claimlist text files which have been preprocessed into a single "mapit.wordvec.*.extr" file. This file consists of a list of each unique term in the original claimlist files followed by a count of the number of occurrences of that term for each document (col. 11, lines 22-28; col. 23, lines 42-45).

Snyder does not explicitly teach the steps of:

b).   automatically determining claim breadth metrics for the multiple claims by using computer to measure claim length;

c).   associating a claim breadth metric with a claim and storing said associated claim breadth metric in a computer-readable dataset; and

d).   wherein a claim breadth metric which is associated with a claim is indicative of how broad the claim is.

Risen, however, teaches the steps of:

b).   determining claim breadth metrics for the multiple claims as valuation of the intellectual property asset is the assignment of a monetary value to the intellectual property asset. This value can be based upon the income and profits generated by the sale or use of the patented technology, the number of remaining on the term of the patent, ***the breadth of the claims***, the nature of the patented technology, the nature of competitive products or processes etc. (col. 9, lines 20-29);

c).   associating a claim breadth metric with a claim and storing said

associated claim breadth metric in a computer-readable dataset (col. 9, lines 29); and

d).   wherein a claim breadth metric which is associated with a claim is

indicative of how broad the claim is (col. 9, lines 29).

It would have been obvious to one of ordinary skill in the art at the time of the

invention was made to combine the teachings of the cited references because **Risen's**

teaching involves determining the breadth of the claim would have allowed **Risen-**

Snyder's to provide the breadth metrics as a means for users to quickly identify the

scope of the claimed subject matter together with other value asset factors in order to

determine the suitable premium for insuring the intellectual property asset or assets as

suggested by **Risen** at col. 9, lines 44-56.

Snyder and Risen do not explicitly teach the step of:

b).   automatically determining claim breadth and using computer to measure

claim length.

Petruzzi, however, teaches "automatically" and "using computer to measure

claim length" as _the computer counts_ (e.g., automatic) the number of words in the

drafting area 290 of the Abstract 110 and reminds the operator if there appears more

than a set amount, e.g., for the U.S. Patent Office, a maximum of 250 words is

preferred… if the maximum has been exceeded, the operator will be prompted to

remove words from the drafting area … removing some of the limitations appearing in
the dependent claims (col. 14, lines 1-16).

It would have been obvious to one of ordinary skill in the art of data processing to
update the Valuator's work in determining a value of an intellectual property asset as
shown in **Risen** and patent texts analysis as shown in **Snyder** with the machine patent
drafting method as shown in **Petruzzi** to keep pace with the current technology and to
gain the commonly understood benefits of such adaptation, such as eliminate time-
consuming, repetitive routine tasks and processes and provide a fast and more effective
way to complete the same task.

Based on the above, it should be apparent to the reader that if **Petruzzi** is able to
count words from the Abstract, it should be able to count words in the claims as well.

*Examiner submits that counting the number of words in a claim to determine the
breadth of the claim is well-known in the field of Patent claim drafting as the longer the
length of the claim, normally, the narrower the scope of the claim and vice versa.
Additionally, it would have been obvious to one of the skilled in art at the time of the
invention was made to automate a manual activity to accomplish the same result in a
quick and more effective manner [In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194
(CCPA 1958)].*

Regarding claims 2 and 12, **Snyder** further teaches a step of counting the
number of words in the claim text for each of said multiple claims (col. 14, lines 36-59).

Snyder does not explicitly teach determining claim breadth metrics and generating claim breadth metrics for the multiple claims therefrom.

Risen, however, teaches the step of determining claim breadth metrics and generating claim breadth metrics for the multiple claims therefrom as valuation of the intellectual property asset is the assignment of a monetary value to the intellectual property asset. This value can be based upon the income and profits generated by the sale or use of the patented technology, the number of remaining on the term of the patent, **the breadth of the claims**, the nature of the patented technology, the nature of competitive products or processes etc. (col. 9, lines 20-29).

Snyder and Risen do not explicitly teach automatically counting the number of words in the claim text.

Petruzzi, however, teaches "automatically" and "using computer to measure claim length" as the _computer counts_ (e.g., automatic) the number of words in the drafting area 290 of the Abstract 110 and reminds the operator if there appears more than a set amount, e.g., for the U.S. Patent Office, a maximum of 250 words is preferred… if the maximum has been exceeded, the operator will be prompted to remove words from the drafting area … removing some of the limitations appearing in the dependent claims (col. 14, lines 8-16).

It would have been obvious to one of ordinary skill in the art of data processing to update the Valuator's work in determining a value of an intellectual property asset as shown in **Risen** and patent texts analysis as shown in **Snyder** with the machine patent drafting method as shown in **Petruzzi** to keep pace with the current technology and to

gain the commonly understood benefits of such adaptation, such as eliminate time-

consuming, repetitive routine tasks and processes and provide a fast and more effective

way to complete the same task.

Regarding claims 3 and 13, **Snyder** does not explicitly teaches a step wherein

said step of automatically determining claim breadth metrics includes automatically

identifying within the claim text for each of said multiple claims a preamble portion and a

body portion, counting the number of words in said preamble and body portions and

applying separate weights to said count to generate a claim breadth metric for each of

said multiple claims.

Risen, however, teaches the step of determining claim breadth metrics and

generating claim breadth metrics for the multiple claims therefrom as valuation of the

intellectual property asset is the assignment of a monetary value to the intellectual

property asset. This value can be based upon the income and profits generated by the

sale or use of the patented technology, the number of remaining on the term of the

patent, ***the breadth of the claims***, the nature of the patented technology, the nature of

competitive products or processes etc. (col. 9, lines 20-29).

Snyder and Risen do not explicitly teach automatically determining claim

breadth metrics.

Petruzzi, however, teaches "automatically determining claim breadth metrics" as

the <u>computer counts</u> (e.g., automatic) the number of words in the drafting area 290 of

the Abstract 110 and reminds the operator if there appears more than a set amount,

e.g., for the U.S. Patent Office, a maximum of 250 words is preferred… if the maximum

has been exceeded, the operator will be prompted to remove words from the drafting

area … removing some of the limitations appearing in the dependent claims (col. 14,

lines 8-16).

It would have been obvious to one of ordinary skill in the art of data processing to

update the Valuator's work in determining a value of an intellectual property asset as

shown in **Risen** and patent texts analysis as shown in **Snyder** with the machine patent

drafting method as shown in **Petruzzi** to keep pace with the current technology and to

gain the commonly understood benefits of such adaptation, such as eliminate time-

consuming, repetitive routine tasks and processes and provide a fast and effective way

to complete a task. Further, it should be noticed that counting the number of words in

said preamble and body portions and applying separate weights to said count to

generate said claim breadth metric is well-known in the field of Patent claim drafting. In

this present case, the ordinary skill in the art would have known that the breadth of a

claim is inversely proportional to the quantity of limitations recited therein.

Examiner submits that counting the number of words in a claim to determine the

breadth of the claim is well-known in the field of Patent claim drafting as the longer the

length of the claim, normally, the narrower the scope of the claim and vice versa.

Additionally, it would have been obvious to one of the skilled in art at the time of the

invention was made to automate a manual activity to accomplish the same result in a

quick and more effective manner [In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194

(CCPA 1958)].

Regarding claims 4, 14, and 18, **Snyder** further teaches a step of determining

claim breadth metrics includes parsing the claim text for each of said multiple claims to

identify parts of speech (col. 13, lines 33-34), using said identified parts of speech to

identify clauses within each of said multiple claims, comparing said clauses with the text

of other claims in said corpus to generate scores indicative of which clauses within said

claim text have a lower probability of being found in other claims within said corpus (col.

3, lines 50-58; col. 4, lines 8-18; col. 17, line 65 – col. 18, line 17).

Snyder and Risen do not explicitly teach automatically.

Petruzzi, however, teaches "automatically" and "using computer to measure

claim length" as the *computer counts* (e.g., automatic) the number of words in the

drafting area 290 of the Abstract 110 and reminds the operator if there appears more

than a set amount, e.g., for the U.S. Patent Office, a maximum of 250 words is

preferred… if the maximum has been exceeded, the operator will be prompted to

remove words from the drafting area … removing some of the limitations appearing in

the dependent claims (col. 14, lines 1-16).

It would have been obvious to one of ordinary skill in the art of data processing to

update the Valuator's work in determining a value of an intellectual property asset as

shown in **Risen** and patent texts analysis as shown in **Snyder** with the machine patent

drafting method as shown in **Petruzzi** to keep pace with the current technology and to

gain the commonly understood benefits of such adaptation, such as eliminate time-consuming, repetitive routine tasks and processes and provide a fast and more effective way to complete the same task.

Regarding claims 5 and 15, **Snyder** further teaches a step of displaying said patent information in a sorted order (col. 27, lines 32-36).

Snyder does not explicitly teach display patent information based on claim breadth metric.

Risen, however, teaches the step of valuation of the intellectual property asset is the assignment of a monetary value to the intellectual property asset. This value can be based upon the income and profits generated by the sale or use of the patented technology, the number of remaining on the term of the patent, *the breadth of the claims*, the nature of the patented technology, the nature of competitive products or processes etc. (col. 9, lines 20-29).

Regarding claim 6, **Snyder** further teaches a step of determining claim breadth metrics includes linguistically processing the claim text for each of said multiple claims to identify at least one clause within said claim text that has a lower probability than other of said clauses within said claim text of being found in other claims within said corpus (col. 3, lines 29-31; col. 4, lines 49-62; and col. 25, lines 7-25).

Snyder and **Risen** do not explicitly teach automatically.

Petruzzi, however, teaches "automatically" and "using computer to measure claim length" as the _computer counts_ (e.g., automatic) the number of words in the drafting area 290 of the Abstract 110 and reminds the operator if there appears more than a set amount, e.g., for the U.S. Patent Office, a maximum of 250 words is preferred… if the maximum has been exceeded, the operator will be prompted to remove words from the drafting area … removing some of the limitations appearing in the dependent claims (col. 14, lines 1-16).

It would have been obvious to one of ordinary skill in the art of data processing to update the Valuator's work in determining a value of an intellectual property asset as shown in **Risen** and patent texts analysis as shown in **Snyder** with the machine patent drafting method as shown in **Petruzzi** to keep pace with the current technology and to gain the commonly understood benefits of such adaptation, such as eliminate time-consuming, repetitive routine tasks and processes and provide a fast and more effective way to complete the same task.

Examiner submits that counting the number of words in a claim to determine the breadth of the claim is well-known in the field of Patent claim drafting as the longer the length of the claim, normally, the narrower the scope of the claim and vice versa. Additionally, it would have been obvious to one of the skilled in art at the time of the invention was made to automate a manual activity to accomplish the same result in a quick and more effective manner [In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958)].

Regarding claims 7 and 19, **Snyder** further teaches a step of displaying said claim text such that said one clause is visually presented differently than the other of said clauses (col. 4, lines 12-16).

Regarding claim 11, **Snyder** teaches a computer-implemented patent portforlio analysis method comprising:

a).   retrieving text of multiple claims from a computer-implemented data store, wherein the text of claims are from a plurality of patent documents (col. 4, lines 3-7 and lines 8-18);

Snyder further teaches analysis of structured documents such as claims within patents, accurately compare claims from two different patents in attempt to identify both the scope and references of the claims. Additionally, the system translate a set of claimlist text files which have been preprocessed into a single "mapit.wordvec.*.extr" file. This file consists of a list of each unique term in the original claimlist files followed by a count of the number of occurrences of that term for each document (col. 11, lines 22-28; col. 23, lines 42-45).

Snyder does not explicitly teach the steps of:

b).   automatically analyzing said retrieved text to identify the independent claims;

c).   automatically analyzing the text of the independent claims in order to generate claim breadth metrics for the independent claims, wherein a claim breadth metric that is associated with a claim is indicative of how broad the claim is.

d).   wherein the claim breadth metrics are used to analyze the multiple claims.

Risen, however, teaches as valuation of the intellectual property asset is the assignment of a monetary value to the intellectual property asset. This value can be based upon the income and profits generated by the sale or use of the patented technology, the number of remaining on the term of the patent, ***the breadth of the claims***, the nature of the patented technology, the nature of competitive products or processes etc. (col. 9, lines 20-29).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Risen's** teaching involves determining the breadth of the claim would have allowed **Snyder's** to provide the breadth and the scope of the claimed subject matter together with other value asset factors in order to determine the suitable premium for insuring the intellectual property asset or assets as suggested by **Risen** at col. 9, lines 44-56.

Snyder and Risen do not explicitly teach the steps of:

b).   automatically analyzing said retrieved text to identify the independent claims.

c).   automatically.

Petruzzi, however, teaches "automatically analyzing said retrieved text to identify the independent claims" as the *computer counts* (e.g., automatic) the number of words

in the drafting area 290 of the Abstract 110 and reminds the operator if there appears

more than a set amount, e.g., for the U.S. Patent Office, a maximum of 250 words is

preferred… if the maximum has been exceeded, the operator will be prompted to

remove words from the drafting area … removing some of the limitations appearing in

the dependent claims (col. 14, lines 1-16).

It would have been obvious to one of ordinary skill in the art of data processing to

update the Valuator's work in determining a value of an intellectual property asset as

shown in **Risen** and patent texts analysis as shown in **Snyder** with the machine patent

drafting method as shown in **Petruzzi** to keep pace with the current technology and to

gain the commonly understood benefits of such adaptation, such as eliminate time-

consuming, repetitive routine tasks and processes and provide a fast and more effective

way to complete the same task.

*Examiner submits that counting the number of words in a claim to determine the
breadth of the claim is well-known in the field of Patent claim drafting as the longer the
length of the claim, normally, the narrower the scope of the claim and vice versa.
Additionally, it would have been obvious to one of the skilled in art at the time of the
invention was made to automate a manual activity to accomplish the same result in a
quick and more effective manner [In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194
(CCPA 1958)].*

Regarding claim 16, **Snyder** further teaches a step wherein the sorted patent

documents are used in a patent infringement study (col. 4, lines 8-18).

Regarding claim 20, **Snyder** further teaches a step wherein the generated

descriptive statistics are indicative of quality of claims analyzed (col. 24, lines 4-20).

Snyder does not explicitly teach generating descriptive statistics based upon the

generated claim breadth metrics.

Risen, however, teaches the step of valuation of the intellectual property asset is

the assignment of a monetary value to the intellectual property asset. This value can be

based upon the income and profits generated by the sale or use of the patented

technology, the number of remaining on the term of the patent, ***the breadth of the***

claims, the nature of the patented technology, the nature of competitive products or

processes etc. (col. 9, lines 20-29).

Regarding claim 21, **Snyder et al.** further teaches a step wherein generated

descriptive statistics are generated for groupings of claims (col. 24, lines 34-39).

Regarding claim 22, **Snyder** further teaches a step wherein the claim groupings

are formed based upon patent ownership, wherein the generated descriptive statistics

are statistics selected from the group consisting of average, average of the averages,

standard deviation, maximum, minimum, and combinations thereof (Fig. 8D).

Regarding claim 31, **Snyder** teaches a computer-implemented patent portfolio

analysis apparatus comprising:

a).   a database of patent documents containing text of claims (col. 4, lines 3-7);

c).   a cluster generator that analyzes patent information to generate category metrics for the patent documents, wherein clusters of patent documents are determined based upon the generated category metrics (col. 23, lines 10-41 and col. 24, lines 49-62), wherein the clusters of patent documents are provided over an internet network for use in analyzing the patent documents (col. 25, lines 40-58).

b).   **Snyder** does not explicitly teach a claim breadth analysis module that analyzes the text of the claims in order to generate claim breadth metrics for the claims, wherein a claim breadth metric is indicative of claim breadth of a claim, wherein the claim breadth metrics are provided over an internet network for use in analyzing scope of the claims.

Risen, however, teaches the step b as valuation of the intellectual property asset is the assignment of a monetary value to the intellectual property asset. This value can be based upon the income and profits generated by the sale or use of the patented technology, the number of remaining on the term of the patent, ***the breadth of the claims***, the nature of the patented technology, the nature of competitive products or processes etc. (col. 9, lines 20-29).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Risen's** teaching involves determining the breadth of the claim would have allowed **Snyder's** to provide the breadth and the scope of the claimed subject matter together with other

value asset factors in order to determine the suitable premium for insuring the

intellectual property asset or assets as suggested by **Risen** at col. 9, lines 44-56.

      Risen and **Snyder** do not explicitly teach "automatically analyzes the text".

      Petruzzi, however, teaches "automatically" as the *computer counts* (e.g.,

automatic) the number of words in the drafting area 290 of the Abstract 110 and

reminds the operator if there appears more than a set amount, e.g., for the U.S. Patent

Office, a maximum of 250 words is preferred… if the maximum has been exceeded, the

operator will be prompted to remove words from the drafting area … removing some of

the limitations appearing in the dependent claims (col. 14, lines 1-16).

      It would have been obvious to one of ordinary skill in the art of data processing to

update the Valuator's work in determining a value of an intellectual property asset as

shown in **Risen** and patent texts analysis as shown in **Snyder** with the machine patent

drafting method as shown in **Petruzzi** to keep pace with the current technology and to

gain the commonly understood benefits of such adaptation, such as eliminate time-

consuming, repetitive routine tasks and processes and provide a fast and more effective

way to complete the same task.

      Examiner submits that counting the number of words in a claim to determine the

breadth of the claim is well-known in the field of Patent claim drafting as the longer the

length of the claim, normally, the narrower the scope of the claim and vice versa.

Additionally, it would have been obvious to one of the skilled in art at the time of the

invention was made to automate a manual activity to accomplish the same result in a

quick and more effective manner [In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194

(CCPA 1958)].

Regarding claim 32, **Snyder** a computer-implemented patent portfolio analysis

method comprising:

a).   retrieving a corpus of patent information from a database, said patent

information including the claim text of a plurality of claims (col. 4, lines 3-7 and lines 8-

18);

Snyder further teaches analysis of structured documents such as claims within

patents, accurately compare claims from two different patents in attempt to identify both

the scope and references of the claims. Additionally, the system translate a set of

claimlist text files which have been preprocessed into a single "mapit.wordvec.*.extr"

file. This file consists of a list of each unique term in the original claimlist files followed

by a count of the number of occurrences of that term for each document (col. 11, lines

22-28; col. 23, lines 42-45).

Snyder does not explicitly teach the steps of:

b).   automatically analyzing the claim text of said plurality of claims to

generate and associate an individual claim breadth metric with each of said plurality of

claims.

Risen, however, teaches the step of analyzing the claim text of said plurality of claims to generate and associate an individual claim breadth metric with each of said plurality of claims as valuation of the intellectual property asset is the assignment of a monetary value to the intellectual property asset. This value can be based upon the income and profits generated by the sale or use of the patented technology, the number of remaining on the term of the patent, ***the breadth of the claims***, the nature of the patented technology, the nature of competitive products or processes etc. (col. 9, lines 20-29).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Risen's** teaching involves determining the breadth of the claim would have allowed **Snyder's** to provide the breadth and the scope of the claimed subject matter together with other value asset factors in order to determine the suitable premium for insuring the intellectual property asset or assets as suggested by **Risen** at col. 9, lines 44-56.

Snyder and **Risen** do not explicitly teach <u>automatically</u> analyzing the claim text.

Petruzzi, however, teaches "automatically analyzing the claim text" as the *computer counts* (e.g., automatic) the number of words in the drafting area 290 of the Abstract 110 and reminds the operator if there appears more than a set amount, e.g., for the U.S. Patent Office, a maximum of 250 words is preferred… if the maximum has been exceeded, the operator will be prompted to remove words from the drafting area

… removing some of the limitations appearing in the dependent claims (col. 14, lines 8-16).

It would have been obvious to one of ordinary skill in the art of data processing to update the Valuator's work in determining a value of an intellectual property asset as shown in **Risen** and patent texts analysis as shown in **Snyder** with the machine patent drafting method as shown in **Petruzzi** to keep pace with the current technology and to gain the commonly understood benefits of such adaptation, such as eliminate time-consuming, repetitive routine tasks and processes and provide a fast and effective way to complete a task.

Examiner submits that counting the number of words in a claim to determine the breadth of the claim is well-known in the field of Patent claim drafting as the longer the length of the claim, normally, the narrower the scope of the claim and vice versa. Additionally, it would have been obvious to one of the skilled in art at the time of the invention was made to automate a manual activity to accomplish the same result in a quick and more effective manner [In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958)].

3.   Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Snyder et al. ("Snyder")**(U.S. Patent 6,038,561) in view of **Risen, Jr. et al. ("Risen")** (U.S. Patent 6,018,714) and **Petruzzi et al. ("Petruzzi")** (U.S. Patent 6049811 A) as applied

to claims 1-7, 11-16, 18-22, and 31-32 above and in view of **Rivette et al.**

(**"Rivette"**)(U.S. Patent 6,339,767 B1).

Regarding claim 17, **Snyder, Risen,** and **Petruzzi** do not explicitly teach a step wherein the sorted patent documents are used to determine patent documents whose maintenance fees are not to be paid.

Rivette, however, teaches a step wherein the Financial Modules perform patent-centric and group-oriented processing of the data in the financial database. Examples of the functions performed by the financial modules include determining the research and design expenditures, determining maintenance fees, and determining cumulative product revenue on a product or product line basis, etc. (col. 94, lines 23-43).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Rivette's** teaching would have allowed **Snyder- Risen's** to project various types of costs on certain products or licensing revenue associated with any patent own by the company at suggested by **Rivette** at col. 94, lines 62-64.

(10) Response to Argument

Arguments with respect to Rejection Group #1: Claims 1-7, 11-22, 31, and 32

Argument (1):   Appellant argues that "…there is an important component

that is lacking from the Risen reference. The Risen reference does not teach the

process of **automatically determining** claim breadth metrics for multiple claims and

that Risen relies on a human to assess the claim breadth metric."

In response to the preceding arguments, Examiner respectfully submits that the

combination of **Snyder, Risen, and Petruzzi** teaches the claimed limitation

"**automatically determining** claim breadth metrics for multiple claims" .

Risen is cited for teaching "<u>**determining**</u> claim breadth metrics for multiple

claims" as valuation of the intellectual property asset is the assignment of a monetary

value to the intellectual property asset. This value can be based upon the income and

profits generated by the sale or use of the patented technology, the number of

remaining on the term of the patent, ***the breadth of the claims***, the nature of the

patented technology, the nature of competitive products or processes etc. (col. 9, lines

20-29). Risen further teaches a method for defining a number of parameters describing

the intellectual property then the values of these parameters are evaluated by any

suitable methods: the VALMATRIX method of Trademark and Licensing Assoc., a

method consisting only of specified and agreed evaluations, or a method based on the

expert opinions (col. 13, lines 53-60).

Risen teaches **determining** claim breadth metrics for multiple claims (col. 13, lines 53-60).

River does not explicitly teach the step of "**automatically determining...**"

Petruzzi, however, teaches the step of "**automatically...**" as a method for drafting a patent application, the claims on display 12 may be selected by highlighting and dragged to the drafting area. *The <u>computer counts</u> (e.g., automatic) the number of words in the drafting area...if the maximum has been exceeded, the operator is prompted to remove* words from the Abstract, detailed description, or *some of the limitations appears in the dependent <u>claims</u>* (col. 14, lines 1-16).

Based on the above, it should be apparent to the reader that if **Petruzzi** is able to count words from the Abstract, it should be able to count words in the claims as well.

Examiner respectfully submits that it has been held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. See MEP 2144.04 section III, In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

III. AUTOMATING A MANUAL ACTIVITY

In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) (Appellant argued that claims to a permanent mold casting apparatus for molding trunk pistons were allowable over the prior art because the claimed invention combined "old permanent-mold structures together with a timer and solenoid

which automatically actuates the known pressure valve system to release the
inner core after a predetermined time has elapsed." The court held that
broadly providing an automatic or mechanical means to replace a manual
activity which accomplished the same result is not sufficient to distinguish over
the prior art.).

Further, it is submitted that it would have been obvious to one of the skilled in art

at the time of the invention was made to automate a manual activity to accomplish the

same result [In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958)].

As such, it would have been obvious to one of the skilled in art at the time of the

invention was made to modify *Risen's teaching of determining a value of the*

intellectually property asset to include the *Petruzzi's teaching of a machine for drafting a*

patent application to keep pace with the technology by automating a manual activity,

such as counting the words in claims, in order to accomplish the same task in a quick,

powerful, flexible, effective and efficient manner.

As a result, the combination of **Risen** and **Petruzzi** teaches the limitation

"**automatically determining** claim breadth metrics for multiple claims" as claimed.

Argument (2):   Appellant further argues that "… Although the Examiner now

concedes that neither Risen nor Snyder teach the step of "**automatically determining**

claim breadth," the Examiner now supports her rejection by adding the teachings of

Petruzzi (6,049,811). Petruzzi, however, does not teach automatically determining claim

breadth. Rather Petruzzi teaches a machine for drafting a patent application, where the

computer performs a word count upon the Abstract, to remind the user when the

Abstract exceeds the maximum of 250 words."

        In response to the preceding arguments, Examiner respectfully submits that

Petruzzi teaches the step of "**automatically…**" as a method for drafting a patent

application, the claims on display 12 may be selected by highlighting and dragged to the

drafting area. ***The <u>computer counts</u> (e.g., automatic) the number of words in the***

drafting area…if the maximum has been exceeded, the operator is prompted to

remove words from the Abstract, detailed description, or ***some of the limitations***

appears in the dependent <u>claims</u> (col. 14, lines 1-16).

        Risen teaches "<u>**determining**</u> claim breadth metrics for multiple claims" as

valuation of the intellectual property asset is the assignment of a monetary value to the

intellectual property asset. This value can be based upon the income and profits

generated by the sale or use of the patented technology, the number of remaining on

the term of the patent, ***the breadth of the claims***, the nature of the patented

technology, the nature of competitive products or processes etc. (col. 9, lines 20-29).

        The fact that **Petruzzi** is able to count words in the Abstract and to prevent the

words from exceeding the threshold limit, it certainly has the structure and mechanism

to count words in the claims as well.

Risen teaches "**<u>determining</u>** claim breadth metrics for multiple claims" and

Petruzzi teaches the "automatic…" element.

As a result, the combination of **Risen** and **Petruzzi** teaches the limitation

"**automatically determining** claim breadth metrics for multiple claims" as claimed.

Argument (3):   Appellant further argues that Risen reference teaches away

from Applicants' invention as Risen explains that an assessment of an intellectual

property asset recited in the "claims" generally entails obtaining a copy of the patent,

and, in at least some cases, its file history. There is nothing in the Risen reference to

suggest that the file history would be analyzed automatically, thus it is apparent that

Risen contemplates that a human would perform the claim breadth assessment.

In response to the preceding arguments, Examiner respectfully submits that

Petruzzi is cited to teach the claimed element "automatically" and NOT **Risen.** As

such, Risen does not teach away from the claimed invention and it is submitted that the

combination of **Risen** and **Petruzzi** teaches the limitation "**automatically determining**

claim breadth metrics for multiple claims" as claimed.

Argument with respect to Rejection Group #2:   Claim 17.

Appellant argues that in Rejection #2, the Examiner adds a further reference, namely Rivette, as teaching the use of financial modules. However, the Rivette reference does not supply the element missing from the Snyder, Risen and Petruzzi references, namely, the automatic determination of claim breadth metrics for multiple claims. Thus the applicants' claims are not met by the Snyder, Rizen, Petruzzi and Rivette combination.

In response to the preceding arguments, Examiner respectfully submits that the combination of Snyder, **Risen** and **Petruzzi** teaches the claimed limitation "**automatically determining** claim breadth metrics for multiple claims" as indicated in the section Argument with respect to Rejection Group #1. As such, Rivette does not have to teach the mentioned limitation. Rivette is cited to teach the limitation of claim 17 which recites: "…wherein the sorted patent documents are used to determine patent documents whose maintenance fees are not to be paid".

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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